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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,720	12/29/2000	John S. Rhoades	99-039-TAP	9219

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EXAMINER

COLIN, CARL G

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,720

Applicant(s)

RHOADES, JOHN S.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 9/8/2004, applicant amends claims 1, 4-7, 12-15, 17-20, and 23-28. The following claims 1-30 are presented for examination.

2. In response to communications filed on 9/8/2004, the objection to claims 2, 15, 23-24, and 28 have been withdrawn in view of the amended claims.

2.1 Applicant's arguments, pages 8-13, filed on 9/8/2004, with respect to the rejection of claim 30 have been fully considered, but they are not persuasive. Applicant argues that the reference does not teach a transportation device that protects against transporting the data storage unit from the second data storage device back to the first data storage device. Examiner respectfully disagrees. Burke discloses that the transport from the second storage (drive) back to the first storage (input/output station) is performed "if the answer to the interrupt request is no" (see figures 9-10 with description), and (see column 11, lines 7-15) that meets the recitation of protecting against transporting back to the first data storage device. Therefore, claim 30 remains rejected in view of Burke.

Regarding claims 1-29, Applicant's arguments, pages 8-13, filed on 9/8/2004, with respect to the rejection of claim 30 have been fully considered, but they are moot in view of a new ground of rejection. Applicant amends claims 1, 4-7, 12-15, 17-20, and 23-28 to further

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limit the claim invention. Upon further consideration, a new ground of rejection is made in view of Munro.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.1 **Claims 1-5, 7-18, 20-29** are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,864,438 to **Munro**.

3.2 **As per claims 1, 14, and 27, Munro** discloses a method and system in a secure gateway for sharing a multiple gateway automated data storage system containing a first data storage unit with data stored within the first data storage unit, comprising the steps of: transmitting the data from the first data storage unit within a first automated data storage system to a second data storage unit, wherein the first automated data storage system comprises a robotic mechanism for transporting data storage units, for example (see column 2, lines 47-57); receiving a request from a second automated data storage system for the second data storage unit wherein the second automated data storage system comprises a second robotic mechanism for transporting data storage units, for example (see column 2, lines 25-35 and column 2, line 64 through column 3,

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line 26). See also column 5, line 40 through column 7, line 11); and transporting the second automated data storage unit to the second data storage system without human handling of the second data storage unit, for example (see column 2, lines 25-35 and column 2, line 64 through column 3, line 26). See also column 5, line 40 through column 7, line 11).

As per claims 2, 15, and 28, Munro discloses the limitation of further comprising: generating an identification qualifier for the second data storage unit, for example (see column 2, lines 25-46 and column 5, lines 21-40).

As per claims 3 and 16, Munro discloses the limitation of wherein the first automated data storage system is a source automated data storage system, for example (see column 2, lines 25-35 and column 2, line 64 through column 3, line 26). See also column 5, line 40 through column 7, line 11).

As per claims 4 and 17, Munro discloses the limitation of wherein the source data storage system is an unclassified data storage system, for example (see column 2, lines 25-35 and column 2, line 64 through column 3, line 26). See also column 5, line 40 through column 7, line 11).

As per claims 5 and 18, Munro discloses the limitation of wherein the second data storage system is a destination automated data storage system, for example (see column 2, lines

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25-35 and column 2, line 64 through column 3, line 26). See also column 5, line 40 through column 7, line 11).

As per claims 7, 20, and 29, Munro discloses the limitation of further comprising: responsive to the transporting step, updating a control data set managed by an automated library data storage system library server, for example (see column 15, lines 30-38).

As per claims 8 and 21, Munro discloses the limitation of wherein the control data set is integrated into the automated data storage system library server, for example (see column 5, lines 15-45).

As per claims 9 and 22, Munro discloses the limitation of wherein the control data set is external to the automated data storage system library server, for example (see column 5, lines 25-38).

As per claims 10-11 and 23-24, Munro discloses the limitation of decataloging and cataloging the second data storage unit from and into the first automated data storage system and notifying the automated library server that the second data storage unit is removed from the first and received at the second automated data storage system, for example (see column 15, lines 10-50 and column 18, lines 45-67; see also columns 13-14).

As per claims 12 and 25, Munro discloses the limitation of wherein transporting the second data storage unit to the second data storage system comprises: controlling movement of the robotic mechanism to transport the second data storage unit to a pass-thru port that interconnects the first automated data storage system with the second automated data storage system, for example (see column 13).

As per claims 13 and 26, Munro discloses the limitation of wherein transporting the second data storage unit to the second data storage system further comprises controlling movement of the second robotic mechanism to transport the second data storage unit from the pass-thru port to the second automated data storage system, for example (see column 13).

4. **Claim 30** is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,613,154 to **Burke et al.**

4.1 **As per claim 30, Burke et al** discloses a secure gateway apparatus for sharing a multiple gateway automated data storage system, the apparatus comprising: a controller that controls transporting a data storage unit from a first data storage device to a second data storage device, for example (see column 15, lines 5-31 and column 10, line 55 through column 11, line 15); and a transportation device that transports the data storage unit from the first data storage device to the second data storage device, wherein the transportation device protects against transporting the data storage unit from the second data storage device back to the first data storage device, for example (see figures 9-10 with description), and (see column 11, lines 7-15).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1 **Claims 6 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,864,438 to **Munro** in view of US Patent Publication US 2004/0073676 to **Honma et al.**

5.2 **As per claims 6 and 19, Munro** substantially teaches a system that controls the sharing and transfer of storage units between a first and second automated data storage systems. **Munro** discloses that the invention is not limited to the specific example provided. **Munro** does not explicitly state using one non-secured data storage system and a secured data storage system. However, **Honma et al** in an analogous art teaches classified and unclassified data storage systems in an enterprise environment and further discloses that even though the sharing reduces cost but considerations should be taken in securing storage units so that all servers cannot access all storage units; for instance, a particular server can be assigned to a storage system so that only

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a registered server can gain access to it, (see pages 9-10, paragraphs 0103-0106). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Munro** to provide classified and unclassified data storage systems in order to implement the invention in a secure environment and control access to at least one of the storage systems as taught by **Honma et al**. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Honma et al** so as to provide security in addition to sharing data.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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6.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses the use of sharing automated data storage system. Many of the claimed features, i.e. cataloging, backup, control access, etc. are disclosed in this reference.

US Patents: 5,287,459 Gniewek 5,537,585 Blickenstaff et al.

6.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday 8:00 AM – 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc
Carl Colin

Patent Examiner

December 11, 2004

E. J. J. J.
EJ
PRINTER
DE